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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,274	10/13/2006	Yuichi Tsuji	71,051-022	6627
27305 7590 12/05/2008 HOWARD & HOWARD ATTORNEYS, P.C. THE PINEHURST OFFICE CENTER, SUITE #101 39400 WOODWARD AVENUE BLOOMFIELD HILLS, MI 48304-5151				
EXAMINER				
ZIMMER, MARC S				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
12/05/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/553,274

Applicant(s)

TSUJI ET AL.

Examiner

MARC S. ZIMMER

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 10/13/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 101/112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 8 provide for the use of a composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 7 and 8 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heeks et al., U.S. Patent Application Publication No. 2004/0253436 (hereinafter '436) in

view of Heeks et al., U.S. Patent # 5,401,570 (hereinafter '570) and Shudo, U.S. Patent Application Publication No. 2002/0146575.

Heeks '236 discloses fuser members, among which include rollers, belts, films, etc. [0001] featuring a substrate on which are applied addition-cured silicone rubber layers and, in some embodiments, an outermost layer comprising a fluoroelastomer [0027-0028]. Relevant to the present discussion, the silicone rubber-forming composition is filled with aluminum oxide and iron oxide. The amounts of base silicone, aluminum oxide, and iron oxide advocated in [0065] are consistent with the relative quantities required by Applicant's claims. It is further contemplated that the fillers be treated with an organosilicon compound for all the reasons delineated in [0066].

As an aside, the Examiner acknowledges that there is a discrepancy in the *Heeks* '236 disclosure in that what is identified as a primary embodiment of the vinyl-functional polymer is not actually vinyl-functional, at least according to the assignments for R^1 through R^5 . On the other hand, they mention commercially available permutations [0061] of the addition-curable composition which, by definition, contains an organosiloxane having at least two alkenyl groups and an organosiloxane having at least two silicon-bound hydrogen moieties hence the Examiner believes that the presence of compounds corresponding to (A) and (E) of Applicant's invention is satisfied.

Heeks '236 does not, however, mention what the particle sizes of the aluminum oxide and iron oxide fillers should be. It is the Examiner's position that, where the reference is silent regarding this parameter, one of ordinary skill would turn to the

related prior art to ascertain what is an appropriate particle size for these components. *Heeks '570* is, likewise, directed to the manufacture of fuser members containing a layer of silicone elastomer but differs from the claimed invention in that the base polymer is silanol-terminated and, thus, cures by a condensation mechanism. Like *Heeks '236*, *Heeks '570* teaches the employment of a combination of iron oxide and aluminum oxide in Example 1 and the sizes of these particles, where 325 mesh equates to a particle size of 45 microns, fall squarely in the claimed ranges. Given that the '236 document is directed to curable silicone compositions for precisely the same purpose, the skilled artisan would take the direction of that reference in selecting an aluminum oxide and iron oxide with particle sizes consistent with those of the claims.

Heeks '236 also does not mention a cerium compound but the Examiner is of the understanding that it is not unusual that this component be added to silicone rubbers used in similar applications to impart heat stability as evidenced by *Shudo* [0048] and others.

Concerning claims 5-6, and 11-20, Applicant is advised that these claims, in the Examiner's estimation, connote product-by-process in the sense that they imply formulating the metal compounds (C) and (D) into a certain state, a paste, prior to their incorporation into the overall composition. The Examiner submits that a reference need not mention this aspect for these claims to be anticipated because, whether or not the iron oxide and cerium compound are first made into a paste with portions of (A), upon blending them with the remaining portion of (A) and components (B), (E), and (F), there will be no patentable distinction between the prior art invention and the claims provided

that the makeup is the same. Moreover, the carrying out of processes in a different sequences, such as blending of ingredients in a different order, has been deemed *prima facie* obvious. *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946) (selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results); see also *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (Selection of any order of mixing ingredients is *prima facie* obvious.) Finally, the creation of concentrates of the base polymer and filler, as opposed to mixing the fillers directly into the bulk matrix is known and practiced with some frequency.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 4, 2008

/Marc S. Zimmer/
Primary Examiner, Art Unit 1796